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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,755	08/28/2001	Nikhil M. Deshpande	884.493US1	5778

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EXAMINER

FLYNN, KIMBERLY D

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

4

Office Action Summary

Application No.

09/940,755

Applicant(s)

DESHPANDE, NIKHIL M.

Examiner

Kimberly D. Flynn

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>03/20/2002</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response an Amendment filed March 24, 2005, claims 1-25 are presented for further consideration.

Response to Arguments

2. Applicant's arguments filed March 24, 2005 have been fully considered, but they are not persuasive. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Carey teaches that it would be advantageous to communicate via instant text message because text messaging as compared to voice communications it is less costly since it utilizes less bandwidth. Therefore, Examiner maintains he combination of Joyce and Carey and also maintains that there is sufficient motivation to combine. (See Paragraph 4).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-25 rejected under 35 U.S.C. 103(a) as being unpatentable over Joyce (U.S. Patent No. 6,798,358 hereinafter, Joyce) in view of Carey (U.S. Patent No. 6,714,793, hereinafter Carey).

In considering claim 1, 13, and 19, Joyce discloses a location-based content delivery system and method comprising:

 sending a first immediate message from a location, wherein the first immediate message comprises a request for information (see Joyce col. 7, lines 25-30); and

 receiving a second immediate message, wherein the second message comprises a response to the request, wherein the response is dependent on the location (see Joyce col. 7, lines 66-67 through col. 8 line 1).

While Joyce discloses that the mobile terminal may query the server via a SMS message, Joyce does not explicitly disclose that the messages are instant or immediate messages.

Nonetheless instant message communication among wireless and non-wireless environment is well known as evidenced by Carey. In similar art, Carey discloses a system and method for instant message communication in a wireless and non-wireless environment wherein messages are sent from a mobile unit device over a wireless communication network (col. 1, lines 60-65).

Given the teachings of Carey, it would have been obvious to a person having ordinary skill in the art to modify the system disclosed by Joyce to include instant messaging capabilities in order to provide subscribers with the benefits of real-time communication on a constantly open communication channel not only in hardwired Internet systems but also in a wireless environment. It would be advantageous to communicate via instant text message because text messaging as compared to voice communications it is less costly since it utilizes less bandwidth,

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and more efficient than playing phone tag or waiting for e-mail replies. Accordingly, text instant messaging is an efficient cost effective way of communicating. Therefore the aforementioned limitation would have been an obvious modification to the system disclosed by Joyce.

In considering claim 2, 15, and 20-21, the combined system of Joyce and Carey discloses that the first immediate message further comprises sending the first immediate message to a user name identified in a buddy list (see Carey col. 8, lines 8-18).

In considering claims 4 and 22, the combined system of Joyce and Carey discloses a system and method comprising:

receiving a first instant message from a sender (see Joyce col. 7, lines 25-30);
determining a location of the sender (see Joyce col. 7, lines 30-39); and
sending a second instant message to the sender, wherein the contents of the second instant message are dependent on the location of the sender (see Joyce col.7, lines 40-59, lines 66-67 through col. 8, line 1, and lines 19-22).

While Joyce discloses the system substantially as claimed, Joyce does not disclose that the messages that are delivered are instant messages. Nonetheless instant message communication among wireless and non-wireless environment is well known as evidenced by Carey. In similar art Carey discloses a system and method for instant message communication in a wireless and non-wireless environment wherein messages are sent from a mobile unit device over a wireless communication network (col. 1, lines 60-65). Given the teachings of Carey, it would have been obvious to a person having ordinary skill in the art to modify the system disclosed by Joyce to include instant messaging capabilities in order to provide subscribers with the benefits of real-time communication not only in hardwired Internet systems but also in a

wireless environment. It would be advantageous to communicate via instant text messages because it is less costly and it utilizes less bandwidth. Therefore the aforementioned limitation would have been an obvious modification.

In considering claims 5, 11, and 23, the combined system of Joyce and Carey discloses that the method further comprises:

parsing contents of the first instant message to determine a meaning of the contents (see Joyce col. 7, lines 30-39), wherein the contents of the second instant message are further dependent on the meaning (col. 7, lines 46-59).

In considering claims 6 and 24, the combined system of Joyce and Carey discloses the method further comprising:

finding information related to the meaning of the contents of the first instant message (see Joyce col. 7, lines 30-35); and building the contents of the second instant message based on the information (col. 7, lines 46-59).

In considering claim 7, the combined system of Joyce and Carey discloses a server, comprising:

data indicating a location of a mobile device (see Joyce col. 3, lines 65-67 through col. 4, lines 1-2); and

a personal-assistance controller to send information to the mobile device, wherein the information is based on the location of the mobile device (col.7, lines 40-59 and col. 8, lines 19-22).

In considering claim 8, 14, and 16, the combined system of Joyce and Carey wherein the mobile device (see Carey Fig. 1 (36)) is connected via a long-lived connection (30, public or private network) to the instant-messaging server (40).

In considering claim 9, the combined system of Joyce and Carey discloses wherein the personal-assistance controller (application server, 18) is to send an instant message to the mobile device, wherein the instant message comprises the information (see Joyce col. 7, lines 55-59, lines 66-67).

In considering claim 10, the combined system of Joyce and Carey discloses a location database comprising the location of the mobile device and the information, wherein the information is specific to the location (see Joyce col. 3, lines 65-67 through col. 4, lines 1-2).

In considering claim 25, the combined system of Joyce and Carey discloses that the location of the sender comprises a location of a hotspot access point (Fig. 1 wireless communication network, 12).

In considering claims 12 and 17, the claims contain limitations substantially the same as those previously rejected in claims 1, 4, and 7 therefore the same grounds of rejection is applicable. Additionally the hotspot access point is functionally equivalent to the wireless communication network 12.

In considering claim 18, the combined system of Joyce and Carey discloses that the personal-assistance controller is to determine the location of the one of the plurality of hotspot-access points via the presence data (see Joyce col. 36-40).

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly D. Flynn whose telephone number is 571-272-3954. The examiner can normally be reached on M-F 8:30 - 5:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 703-305-4792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kimberly D Flynn
Examiner
Art Unit 2153

KDF



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